

DAG:jam 1/5/06 470877 S00004A  
PATENTAttorney Reference Number 7158-71254-03  
Application Number 09/781,592**REMARKS**

Claims 38, 40-43, 46-51, 53-61, 63, 64, 66, 68, 72-77, 79-85, 87, and 88 were pending in this application. This Amendment will cancel claims 41-43, 46-51, 53, and 57-61, and hereafter treats rejections of such claims as moot. Applicants expressly reserve the right to pursue protection of any or all of the canceled subject matter in a subsequent application. This Amendment also will amend claims 38 and 63. Claim 38 has been amended to incorporate the feature of now-canceled claim 41 and to remove alleged new matter. Claim 63 has been amended merely to correct a matter of form. No new matter is introduced by these claim amendments, and no new issues are raised.

Entry of the amendments after final action is appropriate because the amendments are believed to place the claims in a condition for allowance. Moreover, entry of the amendment will reduce the number of claims and remove canceled subject matter from consideration, and thereby simplify issues for appeal.

Upon entry of the foregoing claim amendments, claims 38, 40, 54-56, 63, 64, 66, 68, 72-77, 79-85, 87, and 88 will be pending in this application. Entry of the claim amendments herein and reconsideration of the pending rejections are requested.

**Advisory Action**

Applicants thank Examiner Marvich for her clearly written Advisory Action. The claim amendments submitted in the Amendment and Response to Final Office Action, mailed November 28, 2005 ("November 28, 2005 Response"), were not entered by the Office because, allegedly, "[t]he proposed amendment would raise . . . new issues that would require new consideration." In particular, "[c]onsidering . . . dependent claims 46-51, 53 and 57-61 [would] require[] a new search and new consideration." Claims 46-51, 53, and 57-61 are canceled (without prejudice) by this amendment; therefore, Applicants respectfully submit no new issues are raised by this Amendment.

**Informal Telephone Conference with Examiner Marvich**

Applicants thank Examiner Marvich for the courtesy of an informal telephone conference

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with their representative, Debra A. Gordon, on January 5, 2006. During the telephone conference, the alleged new issues identified in the Advisory Action and the only remaining rejection of claims 63, 64, 66, 68, 72-77, 79-85, 87 and 88 (under 35 U.S.C. §112, ¶2) for lacking proper antecedent basis of one term in claim 63 were discussed. The Examiner agreed that amending claim 63 to correct the antecedent basis of the claim term, "test compound," would place claims 63, 64, 66, 68, 72-77, 79-85, 87 and 88 in a position for consideration of allowance. With regard to new issues allegedly raised by the November 28, 2005 Response, complete agreement was not reached; however, the Examiner provided helpful guidance and agreed to consider claim amendments filed by Applicants in a response to the Advisory Action. As discussed above, it is believed that the cancellation of claims 46-51, 53, and 57-61 eliminates any new issues purportedly raised by the November 28, 2005 Response.

Claim Rejections under 35 U.S.C. §112, 1st paragraph:

Claims 38, 40-43, 46-51 and 53-61 have been rejected under 35 U.S.C. §112, 1st paragraph because the term "multi-subunit protein complex" allegedly is new matter. In particular, the Office alleges that "the term 'multi-subunit protein complex' is given a meaning in the claims that is distinct from that in the specification." Applicants traverse this rejection. Nevertheless, to facilitate prosecution of this application, claim 38 and, therefore, its dependent claims 40 and 54-56 have been amended to remove the disputed phrase. Thus, this rejection is moot and Applicants request that it be withdrawn.

Claim Rejections under 35 U.S.C. §112, 2nd paragraph:

Claims 63, 64, 66, 68, 72-77, 79-85, 87 and 88 have been rejected under 35 U.S.C. §112, 2nd paragraph because the phrase "the test compound" in claim 63 allegedly lacks antecedent basis. Applicants have amended claim 63 so that the first occurrence of the disputed phrase recites "a test compound." In view of this Amendment, Applicants request that the rejection be withdrawn.

Claim Rejections under 35 U.S.C. §102(e):

Claims 38, 40, 43, 48, 53 and 57-61 have been rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Wong *et al.* (U.S. Pat. No. 6,465, 629) as evidenced by Wang *et al.*, *Cell*

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*Growth and Differentiation*, 1(5):233-238, 1990, and Dahiya *et al.*, *Mol. Cell. Biol.*, 20(18):6799-6805. Applicants traverse this rejection at least for the reasons stated in the November 28, 2005 Response.

Nevertheless, merely to facilitate prosecution of this application, claim 38 has been amended to include the feature of now-canceled claim 41. Thus, claim 38 recites, in relevant part, "... a nucleic acid regulatory protein zinc finger DNA binding domain peptide ... " (emphasis added). Wong *et al.* has been cited by the Office as teaching, in relevant part, retinoblastoma (Rb) as a nucleic acid regulatory protein DNA binding domain peptide. Even if Rb specifically bound DNA (which is not admitted), it does not do so via a zinc finger DNA binding domain; thus, neither Rb nor its fragments could be characterized as "... a nucleic acid regulatory protein zinc finger DNA binding domain peptide ... " Accordingly, Wong *et al.* can not anticipate claim 38 and its dependent claims because Wong *et al.* does not teach all of the elements of these claims (even when evidenced by Wang *et al.* and Dahiya *et al.*). Applicants respectfully request that this rejection be withdrawn.

Claim Rejections under 35 U.S.C. §103(a):

Claims 47 and 53 have been rejected under 35 U.S.C. §103(a) as allegedly being obvious in light of Wong *et al.*, as evidenced by Wang *et al.* and Dahiya *et al.*, in view of Strober *et al.*, *Mol. Cell. Biol.*, 16(4):1576-1583, 1996. Applicants traverse this rejection at least for the reasons stated in the November 28, 2005 Response. Nevertheless, merely to facilitate prosecution of this application, claims 47 and 53 have been canceled. Thus, this rejection is moot and Applicants request that it be withdrawn.

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### CONCLUSION

It is respectfully submitted that the present claims are in a condition for allowance. If it may further issuance of these claims, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,

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